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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.

Plaintiff,

v.

GOOGLE INC.

Defendant.

Case No. 3:10-cv-03561-WHA

**GOOGLE’S OPPOSITION TO
ORACLE’S MOTION *IN LIMINE* NO. 2
TO EXCLUDE EVIDENCE OR
ARGUMENT THAT GOOGLE RELIED
ON LEGAL ADVICE IN MAKING ITS
DECISIONS TO DEVELOP AND
RELEASE ANDROID**

Judge: Hon. William Alsup

Date Comp. Filed: October 27, 2010

Trial Date: October 31, 2011

Oracle moves *in limine* for the Court to preclude Google from generally relying on advice of counsel to rebut allegations of willful patent and copyright infringement and intent to induce patent infringement, but then leaps to the conclusion that the Court should broadly exclude any evidence or argument whatsoever that Google relied on *any* legal advice in deciding to develop and release Android. Such a categorical request disregards the Court’s September 2, 2011 Order Regarding Pretrial Filings (Dkt. No. 384), which unambiguously states that the parties’ motions *in limine* “must be directed at excluding specific items of evidence; categorical motions and disguised summary judgment motions are highly disfavored.” Regardless, Oracle’s motion far exceeds requesting the exclusion of “specific items of evidence” relating to issues of willfulness and inducement. Accordingly, Oracle’s Motion *In Limine* No. 2 should be denied.

A. Oracle’s motion should be denied as moot because Google does not rely on an advice-of-counsel defense with respect to willfulness or inducement

At least with respect to its allegations of willfulness and inducement, Oracle’s Motion *In Limine* No. 2 should be denied as moot. There is no evidence to suggest that Google even relies on advice of counsel as a defense to willful patent infringement or inducing patent infringement.¹ (And lest there be any confusion—Google does not.) Thus, there’s no related evidence to exclude.

B. Oracle seeks to expand Patent Local Rule 3-7 to exclude any evidence of any advice of counsel related to the development of Android

Oracle asks this Court not just to exclude evidence regarding advice of counsel to defend a willfulness or inducement charge, but to exclude *all* evidence concerning *any* advice of counsel. Specifically, Oracle relies on Patent L.R. 3-7, which provides for the production of any written advice and documents and written summaries of any oral advice and related documents *for which the attorney-client and work product protection have been waived*. But Oracle points to no evidence for which it believes Google’s privilege assertions would have been waived on

¹ In fact, Google never had a reason to seek advice of counsel prior to July 209, 2010, as that was the first time Oracle gave Google notice of those patents

1 account of potential reliance on advice of counsel to defend against the willfulness and
2 inducement charges.

3 To the contrary, the cases cited by Oracle provide no support for entirely and
4 categorically precluding Google from demonstrating that Google operated based on the advice of
5 counsel in connection with other issues—i.e., the general development of Android—having
6 nothing to do with Google’s rebuttal of Oracle’s willfulness and inducement allegations. Indeed,
7 even Oracle acknowledges that the cases that it cites solely relate to reliance on advice of counsel
8 with respect to issues of willfulness and/or inducement; they do not support such a blanket and
9 categorical exclusion of evidence related to advice of counsel generally.

10 **C. Conclusion**

11 In the face of the Court’s Order Regarding Pretrial Filings, which strongly discouraged
12 “categorical motions and disguised summary judgment motions,” Oracle has presented a motion
13 *in limine* that seeks to broadly preclude Google from presenting at trial an entire category of
14 evidence. Google has not relied on the advice of counsel as a defense to willfulness and
15 inducement because it is clear from the record that Google had no notice of the specific asserted
16 patents and no knowledge that its activities constituted infringement of the patents- and
17 copyrights-in-suit (for which it would have sought such advice) until just weeks before the
18 lawsuit. Oracle’s improper attempt to extend a moot point to categorically preclude Google’s
19 overall reliance on advice of counsel in the overall development of Android is unwarranted and
20 should be denied.

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22 Dated: October 4, 2011

KEKER & VAN NEST LLP

23 By: s/ Robert A. Van Nest

24 ROBERT A. VAN NEST
25 Attorneys for Defendant
26 GOOGLE INC.
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